

REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe the subject matter which applicants regard as the invention.

Claims 9-10 and 13-14 were objected to under 37 CFR 1.75 for being dependent upon withdrawn claim 7. Accordingly, claims 9-10 and 13-14 have been amended, as necessary, herein to depend from claim 8. Withdrawal of this objection is respectfully requested.

Claims 4 and 6 were rejected under 35 U.S.C. 102(b) as being anticipated by Nevo et al. (U.S. Patent No. 5,371,790). Traversal of this rejection is made for at least the following reasons. Nevo et al. does not disclose a portable telephone unit comprising soft material formed on surface of upper and lower cases formed of a hard material, as recited in independent claim 4. The Examiner improperly relies on an electromechanical unit 32 and a sub-housing 52 as being equivalent to the claimed upper and lower cases formed of a hard material. An electromechanical unit 32 is not a case. Rather, the electromechanical unit 32 includes a matrix of pushbutton elements 42, activation of which provides tone or pulse signals for dialing. Col. 3, lines 3-5. Further, as illustrated in Fig. 5 of Nevo et al., the electromechanical unit 32 is housed within the sub-housing 52. Thus, it is not clear how the electromechanical unit 32 can be considered either of an upper or lower case as contended by the Examiner. Further, Nevo et al. explicitly states that "the housing 10 is not formed of a rigid plastic or the like, but is rather formed of a closed cell foam product." Col. 2, lines 21-22. Further still, assuming *arguendo* that the electromechanical unit 32 and sub-housing 52 can be considered equivalent to the claimed upper and lower cases, the foam layers 20-26 are not formed on a surface of the electromechanical unit 32 and sub-housing 52. Thus, Nevo et al. does not disclose upper and lower cases formed of a hard material and soft material formed on the surface of the upper and lower cases, as required by claim 4.

Because Nevo et al. does not disclose each and every limitation set forth in claim 4, Nevo et al. cannot anticipate such claim. Withdrawal of this rejection is respectfully requested.

Claims 1-2, 8-10, and 13-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Otake (JP 6-268548) in view of Bent et al. (U.S. Patent No. 5,613,237). Traversal of this rejection is made for at least the following reasons. The combination of Otake and Bent et al. does not teach or suggest a portable telephone unit wherein a portion of a surface of soft material is corrugated to facilitate shock absorption, as recited in independent claim 8. The Examiner uses Otake as a primary reference to teach the claimed waterproof rib and groove formed of soft material, each located on a periphery of one of the cases, and Bent et al. as a secondary reference to modify the shape of the rib disclosed in Otake. The Examiner then contends "it would have been obvious ... to modify Otake's soft material with a corrugated portion as taught by Bent, such that to improve the gripping of the device, and to provide a device that is simple and easy to assemble." However, Bent et al. discloses that the ease of assembly of the housing is a result of the latch system between the housing and the elastomeric interlocking band. Thus, if one skilled in the art would have been motivated by Bent et al. "to provide a device that is simple and easy to assemble", as contended by the Examiner, the latch connection of Otake would have been modified, not the surface configuration of the soft material.

The ease of assembly has nothing to do with the corrugations on the elastomeric interlocking band. There is nothing within Bent et al. that discloses any improved gripping of the housing. Further, there is nothing within Bent et al. that discloses any benefit of the corrugations on the elastomeric interlocking band. Accordingly, one skilled in the art would not have been motivated by Bent et al. to modify the soft material of Otake to provide corrugations on a surface thereof.

Because the combination of Otake and Bent et al. does not teach or suggest each and every limitation set forth in independent claim 8, such claim cannot be rendered obvious by the combination of Otake and Bent et al. Claims 1 and 2 have been cancelled herein. Accordingly, withdrawal of this rejection is respectfully requested.

Appl. No. 09/719,454
Amdt. Dated March 31, 2005
Reply to Office action of December 16, 2004

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any fees required by this communication, please charge such fees to our Deposit Account No. 16-0820, Order No. 33193.

Respectfully submitted,
Pearne & Gordon LLP

A handwritten signature in black ink, appearing to read 'Una L. Lauricia', is written over a horizontal line.

Una L. Lauricia, Reg. No. 48998

1801 East 9th Street
Cleveland, Ohio 44114-3108
216-579-1700
March 31, 2005